

PATENT

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Attorney Docket No. 05725.1030-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

K. CHRISTOPHIDES-LORDI et al.

Application No.: 10/080,066

Filed: February 22, 2002

For: METHODS FOR MODIFYING THE
APPEARANCE OF A SUBSTRATE

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) Group Art Unit: 1616
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) Examiner: Edward J. Webman
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action dated May 20, 2005, the period for response having been extended two months by the accompanying petition and fee to October 20, 2005, Applicants respectfully request reconsideration of this application in view of the following remarks. A Notice of Appeal is filed concurrently herewith.

Claims 1, 7-16, and 37-39 are pending in this application. Claims 37-39 were withdrawn from consideration by the Examiner as directed to non-elected subject matters. Advisory Action dated September 6, 2005. Therefore, claims 1 and 7-16 are currently subject to examination. No amendments were made after the Final Office Action.

Rejection under § 103(a) Is Improper because the Examiner Has Failed to Establish a *Prima Facie* Case of Obviousness

The Examiner rejects claims 1 and 7-16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,019,962 to Rabe et al. ("*Rabe*"). Final Office Action, p. 2. This is the sole rejection in the Final Office Action. Applicants respectfully traverse this rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met, including that the prior art reference must teach or suggest all the claim limitations and that there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references to arrive at the presently claimed invention. M.P.E.P. § 2143. The suggestion or motivation "must be found in the prior art reference, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

A. Lack of Suggestion or Motivation to Modify *Rabe*

The Examiner has failed to point to any evidence of a suggestion or motivation to modify *Rabe* to arrive at the presently claimed invention. The Examiner has apparently adopted an improper hindsight approach.

Rabe discloses, under "Optional Ingredients," solid formers, such as "a. [s]olid [p]olyol [p]olyesters," "b. [w]axes," and "c. [s]olid [o]ils." Col. 4, line 61 - col. 9, line 27. For each type of the solid formers, *Rabe* further discloses a laundry lists of examples. "WP 660" is disclosed in *Rabe* as an optional ingredient, *i.e.*, an example of the synthetic waxes, among a laundry list of many other kinds of the solid formers. Col. 8, lines 20-24. Therefore, contrary to the Examiner's allegation, WP 660 is not used to achieve *Rabe*'s beneficial effect of improved lubricity, but merely serves as an optional

solid former. Indeed, Example 6 disclosed in *Rabe*, which the Examiner relies on for the disclosure of an eye shadow, does not contain "WP 660." See col. 19, lines 1-25.

Accordingly, the Examiner has failed to point to any evidence of a suggestion, motivation, or guidance that would have led one of ordinary skill in the art to pick and choose "WP 660" for use in an eye shadow over other optional ingredients disclosed in *Rabe*.

Nevertheless, the Examiner alleges that "the compositions [disclosed in] examples 5, 8, or 11 in columns 11, 12, and 14 respectively [of *Rabe*] contain Ganex Wax WP-660, [and] may be applied over the cosmetic product of column 19, the eye shadow," to arrive at the present claim 1. The Advisory Action. Applicants respectfully disagree.

Besides the compositions in examples 5, 8, and 11 in columns 11, 12, and 14, respectively, *Rabe* equally discloses compositions in examples 1-4, 6, 7, 9, 10, and 12-16 in columns 10-16, which do not contain WP-660. Without using the present invention as a blueprint, the Examiner has failed to point to any evidence of a suggestion or motivation to pick and choose the compositions containing WP 660 in the examples 5, 8 and 11, but disregard the compositions in the examples 1-4, 6, 7, 9, 10, and 12-16, which do not contain WP 660.

Further, besides the eye shadow disclosed in Example 6, *Rabe* equally discloses other types of cosmetic products using its composition, including lip cosmetic products in Examples 1 and 4, a liquid foundation in Example 2, a mascara in Example 3, and a liquid eye liner in Example 5. Col. 16, line 20 - col. 18, line 67. In addition, *Rabe* emphasizes the attributes of long-wearing cosmetic products, such as lip products, are

enhanced by its compositions. Col. 2, lines 19-64. However, nowhere does *Rabe* suggest or motivate one of ordinary skill to choose “WP 660” for use in an eye shadow and to apply its composition “to skin with dark circles surrounding the eyes” “to reduce the appearance of the dark circles” as recited in, for example, the present claim 1. Picking and choosing among isolated disclosures in the reference to deprecate the claimed invention amounts to improper hindsight reconstruction and is prohibited under section 103. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

B. Lack of Teaching of Every Limitation of the Rejected Claims

The Examiner has also failed to establish that *Rabe* teaches or suggests each and every limitation of the rejected claims. Specifically, the Examiner has failed to establish that *Rabe* teaches or suggests a “method of reducing the appearance of dark circles around eyes comprising applying to skin with dark circles surrounding the eyes a composition comprising at least one copolymer” as recited in, for example, the present claim 1.

Rabe discloses “compositions and methods for using said compositions with cosmetic products” “to improve the performance of long-wearing cosmetic products.” Col. 1, lines 14-16; col. 1, line 66 - col. 2, line 3. The cosmetic products disclosed in *Rabe* have “a solubility parameter less than or equal to $8.5 \text{ (calories/cm}^3)^{1/2}$.” Col. 1, line 67 - col. 2, line 3; col. 2, line 65 - col. 3, line 1. The inventive compositions disclosed in *Rabe* “comprise oils having a C log P value greater than or equal to 13.” Col. 2, lines 3-5. *Rabe* further discloses that the “compositions and methods for using such compositions enable the user to significantly enhance the attributes of long-wearing

cosmetic products without compromising their primary advantage" (col. 1, lines 16-19), wherein the attributes, in the case of lip products, "include gloss, shine and lubricity." Col. 2, lines 19-25.

Nowhere does *Rabe* teach or suggest applying its composition "to skin with dark circles surrounding the eyes" "to reduce the appearance of the dark circles" as recited in, for example, the present claim 1. The Examiner merely concludes without explanation that "it would be an obvious expedient, even to the layman, to use the Rabe et al eye shadow to disguise the appearance of dark circles around the eyes." Final Office Action, p. 2; *see also* the Advisory Action. However, eye shadow is not used to reduce the appearance of the dark circles around eyes. Therefore, the Examiner has failed to establish that *Rabe* teaches or suggests each and every limitation of the rejected claims.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request that this rejection be withdrawn.

Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and timely allowance of the rejected claims.

If there is any additional fee due in connection with the filing of this paper, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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